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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/785,473	02/24/2004	James F. Allsup	AI 7391 C1	8554
1688 7590 02/13/2009 POLSTER, LIEDER, WOODRUFF & LUCCHESI 12412 POWERSCOURT DRIVE SUITE 200 ST. LOUIS, MO 63131-3615				
EXAMINER				
JOHNSON, GREGORY L				
ART UNIT		PAPER NUMBER		
3691				
MAIL DATE		DELIVERY MODE		
02/13/2009		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/785,473

**Applicant(s)**

ALLSUP ET AL.

**Examiner**

GREGORY JOHNSON

**Art Unit**

3691

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 24 February 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-28 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-28 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SF/ICE)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

1. This communication is in response to the application filed February 24, 2004.

***Priority***

2. Applicant's claim for priority pursuant to 35 U.S.C. § 119(e) to U.S. Provisional Application Number 60/189,551 filed March 15, 2000 is acknowledged.

***Claim Objections and Claim Status***

3. Claims 8 and 27-28 are objected to because of the following informalities:

Claim 8 recites (last limitation) "allowing access by the third party to a computer configured to perform **selected of the** above-recited steps..." The claim language is unclear. Appropriate correction is required.

Claim 27 recites "The improvement of claim 24..." and

Claim 28 recites "The method of claim 24..."

Perhaps Applicants meant to have claims 27-28 depend from claim 26?

Appropriate correction is required.

***Claim Rejections - 35 USC § 112***

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. Claim 26-28 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

Claim 26 is a single means claim and therefore, does not comply with the enablement requirement of 35 U.S.C. 112, first paragraph. See MPEP § 2164.08(a).

Claims 27-28 are rejected to because of their dependency on claim 26.

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claims 1-5, 8-15 and 19-25 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 recites (last limitation) "**monitoring** by the third party..."

Claim 4 recites (last limitation) "providing the client... **access**... client can **monitor**..."

Claim 8 recites (last limitation) "allowing **access** by the third party... third-party can **monitor** and **participate**..."

Claim 12 recites (first limitation) "third party has **access** to a database through which the third party can **monitor**..."

It is unclear if the method steps are being performed by the third party or another entity. In the absence of another entity being disclosed and broadly interpreting the steps of the method, it is not unreasonable to conclude that the steps could be performed by the third party. Applicants should clarify who is performing the method steps (e.g. inclusion of the term "service provider" as used in claim 19). Appropriate correction is required.

Claims 2-3, 5, 9-11 and 13-15 are rejected to because of their dependency on either claim 1, 4, 8 or 12.

Claim 19 recites (second limitation) "**calculating** and electronically **submitting** to the service provider..."

It is unclear who/what is doing the calculating and submitting. Applicants should clarify who/what is performing this particular steps. Appropriate correction is required.

Claims 20-25 are rejected to because of their dependency on either claim 19.

### ***Claim Rejections - 35 USC § 101***

**8. 35 U.S.C. 101 reads as follows:**

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claim 35 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. There are four (4) statutory categories for claiming an invention and they are as follows:

- 1) process or method (which may be a process of making something or a process of using something),
- 2) a machine or apparatus,
- 3) a manufacture (article), and
- 4) a composition of matter.

In regards to the independent claim 35 (Computer software...), the claim is directed to non-statutory subject matter (i.e. software). Appropriate correction is required.

Claims 1-5, 7-15 and 17-25 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Claims 1-3 recite a process comprising the steps of obtaining, filing, calculating, recovering and monitoring.

Claims 4-5 recite a process comprising the steps of obtaining, capturing, and providing.

Claim 7 recites a process comprising the steps of determining, filing, obtaining, establishing, calculating, accessing, recovering and returning.

Claims 8-11 recite a process comprising the steps of determining, obtaining, filing, establishing, calculating, recovering and allowing.

Claims 12-15 recite a process comprising the steps of capturing, access, monitor, calculate, submit and remove.

Claims 17-18 recite a process comprising the steps of determining, filing, obtaining, establishing, calculating, accessing, recovering, participating and returning.

Claims 19-25 recite a process comprising the steps of obtaining, calculating, submitting and recovering.

Based on Supreme Court precedent, a proper process must be (1) tied to another statutory class (such as a particular apparatus) or (2) transform underlying subject matter (such as an article or materials) to a different state or thing (*Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972); *Cochrane v. Deener*, 94 U.S. 780,787-88 (1876)). Since neither of these requirements is met by the claim, the method is not considered a patent eligible process under 35 U.S.C. 101. To qualify as a statutory process, the claim should (1) positively recite the other statutory class to which it is tied, for example by identifying the apparatus that accomplished the method steps (e.g. the primary step(s) within the claims) or (2) positively recite the subject matter that is being transformed, for example by identifying the material that is being changed to a different state. In the instant application, the claims fail to recite any other statutory class (i.e. computer) to which the process is tied. Appropriate correction is required.

Claims 2-3, 5, 9-11, 13-15, 18 and 20-25 do not correct the defect of the independent claims and are rejected to because of their dependency on either claim 1, 4, 8, 12, 17 or 17.

### ***Double Patenting***

9. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

10. Claims 1-28 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-10 of U.S. Patent No. 7,260,548.

Although the conflicting claims are not identical, they are not patentably distinct from each other because the variations in the claims would have been obvious to one of ordinary skill in the art at the time of the invention. For example, the four primary limitations (1-2 and 4-5) within claim 1 of the instant application recite the process steps comprising obtaining, filing, obtaining and recovering. The steps are essentially performing and accomplishing the same results as those by the primary limitations of claim 1 in Patent No. 7,260,548. The claims differ in the following two areas:

Patent No. 7,260,548 includes the following limitation:

- determining if the disabled individual qualifies to receive SSDI.



The instant application includes the following limitation:

- monitoring by the third party of the progress of the afore recited steps, said monitoring being performed concurrently with the afore recited steps.

The pending independent claim 17 is narrower than the patented claim. However, one could not make and use the pending invention without infringing on the already patented claims. In addition, it would have been obvious to one of ordinary skill in the disability insurance art at the time of Applicant's invention to know that the steps in the instant application could not be performed if the disabled individual did not qualify for SSDI.

#### ***Allowable Subject Matter***

11. Claims 1-28 would be allowable if rewritten or amended to overcome the objections, and the rejection(s) under 35 U.S.C. § 112, (1<sup>st</sup> and 2<sup>nd</sup> paragraphs) and 35 U.S.C. § 101, as set forth in this Office action.

#### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to GREGORY JOHNSON whose telephone number is (571)272-2025. The examiner can normally be reached on Monday - Friday, 8:30AM - 5:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, ALEXANDER KALINOWSKI can be reached on (571) 272-6771. The fax

phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Alexander Kalinowski/  
Supervisory Patent Examiner, Art Unit 3691

GREGORY JOHNSON  
Examiner, Art Unit 3691